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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,550	12/28/2001	Kenichi Hashizume	4925-200	1402

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EXAMINER

COLE, ELIZABETH M

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,550

Applicant(s)

HASHIZUME ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 16, 17 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11, 16, 17 and 34-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5, 6-10, 16-18, 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000176964 in view of "What is injection molding", Intelligent Systems Laboratory and in view of JP 05050433. JP '964 discloses an injected molded material comprising a cellulosic base sheet, a resin layer and a transparent resin that is injection molded onto the base sheet. See page 2, paragraph 0027 of the machine translation. The transparent resin may comprise an acrylic or polycarbonate resin. See page 2, paragraph 0028 of the machine translation. The base sheet may comprise a cloth of cellulosic, (i.e., natural), fibers. See abstract. The base sheet may comprise pictures or other designs. See page 3, paragraph 0035. JP '964 differs from the claimed invention because it does not disclose that a portion of the resin surface layer protrudes from the surface. "What is Injection Molding" shows that injection molded articles can be formed so that the shape comprises a portion which protrudes from the planar surface of the article. Further, "What is Injection Molding" shows that injection molded parts conform to the shape of the mold. Therefore, it would have been obvious to have formed the injected molded part of JP '964 into whatever shape was desired depending upon the final use of the molded part. JP '964 does not disclose that the injection molded part is part of an electronic device casing. JP '05050433 teaches that housings for electronics may be formed from textile-reinforced, injection molded plastics. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the material of JP '964 into housings for electronic

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parts. One of ordinary skill in the art would have been motivated to form electronic housings from the material of JP '964 by the teaching of JP '433 that electronic housings may be formed from fiber-reinforced injection molded materials.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '964 in view of "What is injection Molding" as applied to claims 2, 4, 5, 6-10, 16-18 above and in view of JP 05050433, and further in view of Bompard et al, U.S. Patent no. 5,484,642. JP '964 does not disclose the particularly claimed fibers. Bompard teaches at col. 3, lines 43-51 that glass, carbon, aramid or metallic fibers may be used as the reinforcement for injection molded parts. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed the fibers taught by Bompard in the molded part of JP '964. One of ordinary skill in the art would have been motivated to employ the fibers disclosed in Bompard because these fibers are taught as being particularly suitable for use in injection molded parts.

3. Newly submitted claim 39-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 39-40 are drawn to a method of making a casing part. The claimed product can be made by another and materially distinct process such as forming the part in a single mold.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Applicant's arguments filed 2/19/04 have been fully considered but they are not persuasive. Applicant argues that the teachings of JP '964 and "What is injection Molding?" are

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incompatible because the “964 application is directed to decorative wall sheets, the switch panel of a motor vehicle, furniture, building or stationary and there is therefore no reason to combine the teachings of ‘964 with the teachings of “what is injection molding” in order to arrive at a casing for an electronic device. However, the combination of the two references was not made to teach an electronic device since the claims as previously presented did not include that limitation. Therefore, these arguments are not persuasive. Applicant also argues that the claimed invention is directed to making the thickness of all or part of the casing thinner while maintaining the structural integrity of the casing. However, none of the claims recite any thicknesses of any portions of the casing. Also, with regard to the shape of the molded part, since in injection molding the shape of the part corresponds to the shape of the mold, it would have been obvious to have selected the particular shape of the mold in order to form a correspondingly shaped part. With regard to the combination of the above two references with JP ‘433, Applicant argues that the claims are allowable for the reasons put forth regarding the combination of JP ‘964 and “what is injection molding”. However, JP ‘433 teaches forming electronic device housing parts by injection molding. Therefore, the teachings of JP ‘433 are properly combinable with the teachings of JP ‘964 and “what is injection molding”. Therefore, the rejection has been maintained.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.


Elizabeth M. Cole
Primary Examiner
Art Unit 1771

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